

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Art Unit : 1643
Examiner : B. Tedeschi
Serial No. : 09/481,990
Filed : January 11, 2000
Inventor : Florian Lesage

36th Floor
1600 Market Street
Philadelphia, PA 19103

Docket: 1201-DIV-00
(Formerly 989.6351DIV)



#5
D.G.
1/22/01

: Eric Guillemare
: Michael Fink
: Fabrice Duprat
: Michel Lazdunski
: Georges Romey
: Jacques Barhanin
Title : FAMILY OF MAMMALIAN
: POSTASIUM CHANNELS, THEIR
: CLONING AND THEIR USE,
: ESPECIALLY FOR THE SCREENING
: OF DRUGS

Dated: January 12, 2001

RESPONSE TO RESTRICTION REQUIREMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

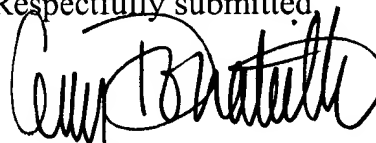
In response to the Restriction Requirement dated December 12, 2000, applicants hereby elect to prosecute the invention of Group II and corresponding Claims 11-13 drawn to proteins. This election is made with traverse. As stated in the Office Action,

Inventions II and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP §

806.05(h)). In the instant case the protein product as claimed can be used in a materially different process of using that product; for instance, the potassium channel protein could be used as an immunogen to make an antibody.

Under the Utility Examination Guidelines effective January 5, 2001, published at Federal Register Volume 66, No.4, page 1092, as applied to the present application, the Patent Office has taken the position that the use of the protein product as claimed as an immunogen to raise an antibody would not constitute a specific, substantial, and credible utility so as to meet the requirements of 35USC § 101. As such, the Examiner's proposed utility, and the basis for the Restriction Requirement, is not, under the Office Guidelines, specific, substantial, and credible, and therefore should not form the basis of a valid Restriction Requirement in this case. For this reason, applicants contend that Groups II and III should be combined, and therefore applicants would elect this combined Group II and III and corresponding Claims 9, 11-13, and 15-19.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Guy T. Donatiello", written over a horizontal line.

Guy T. Donatiello
Reg. No. 33,167
Attorney for Applicants

GTD:ct
(215) 751-2463

GP/1643

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Art Unit : 1643
Examiner : B. Tedeschi
Serial No. : 09/481,990
Filed : January 20, 2000
Inventor : Florian Lesage

36th Floor
1600 Market Street
Philadelphia, PA 19103

Docket: 1201-DIV-00
(Formerly 989.6351DIV)



Inventor : Eric Guillemare
: Michael Fink
: Fabrice Duprat
: Michel Lazdunski
: Georges Romey
: Jacques Barhanin
Title : FAMILY OF MAMMALIAN
: POSTASIUM CHANNELS, THEIR
: CLONING AND THEIR USE,
: ESPECIALLY FOR THE SCREENING
: OF DRUGS

Dated: January 12, 2001

RECEIVED
RECEIVED

JAN 19 2001

TECH CENTER 1600/2900
TECH CENTER 1600/2900

Assistant Commissioner for Patents
Washington, D.C. 20231

RECEIVED

Sir:

JAN 19 2001

Certificate of Mailing Under 37 CFR 1.8

TECH CENTER 1600/2900

For

Postcard

Response to Restriction Requirement

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to Assistant Commissioner for Patents, Washington, D.C. 20231, on the date appearing below.

Name of Applicant, Assignee, Applicant's Attorney
or Registered Representative:

Schnader, Harrison, Segal & Lewis
Suite 3600
1600 Market Street
Philadelphia, PA 19103
(215) 563-1810

By:

Date:

January 12, 2001